REMARKS

Claims 36-39, 57 and 58 are pending. By this Amendment, independent claim 36 is amended to even more clearly distinguish over the applied references, and claims 44 and 59 are canceled. No new matter is added by the above amendments.

Claims 36, 37, 44, 58 and 59 stand rejected under 35 U.S.C. §103(a) over Okada et al. (U.S. Patent No. 6,266,483) in view of Itoh et al. (US2001/0016108) and Wood et al. (US2002/0054752). The rejection is moot with respect to canceled claims 44 and 59. The rejection is respectfully traversed with respect to claims 36, 37 and 58.

Applicant respectfully submits that the applied references do not render obvious independent claim 36 or any of its dependent claims. Applicant respectfully submits that the Office Action impermissibly engages in hindsight reasoning in rejecting independent claim 36. In particular, the Office Action fails to consider Applicant's claims as a whole and fails to consider each reference as a whole. Rather, the Office Action: (1) impermissibly over generalizes claim 36 by viewing only the differences between claim 36 and Okada et al. as the "invention", then (2) generalizes the differences by characterizing the them as storing a higher priority data over another data, rather than considering the specific different types of data recited in independent claim 36. The Office Action then (3) improperly overly-broadly analyzes the references by asserting that the references teach that it is known to record a higher priority type of data over another type of data, even though none of the applied references discloses that data of a visual broadcast program should take precedence over digital image data that is not a broadcasting program, as recited in independent claim 36. Thus, the Office Action fails to consider Applicant's claims as a whole and fails to consider the references as a whole. See, for example, MPEP 2141.02 and 2141.03.

As Applicant has previously argued, the Office Action recognizes that Okada et al. fails to disclose the claim 36 controller "that controls the recording circuit to interrupt the recording

of the digital image data, when recording instructions of the visual broadcast program are detected during the recording of the digital image data." As Applicant has previously argued, Okada et al. fails to even appreciate that the situation could exist in which recording instructions of a visual broadcast program are detected during the recording of digital image data. Thus, one having ordinary skill in the art would have no reason to modify Okada et al. as proposed by the Office Action. Wood et al. and Itoh et al., as will be described below, do not disclose interrupting the recording of digital image data when recording instructions of a visual broadcast program are detected during the recording of the digital image data. That is, neither Wood et al. nor Itoh et al. discloses that the recording of a visual broadcast program should be given priority over the recording of the claimed digital image data. Thus, the combination of features recited in independent claim 36 would not have been obvious to one having ordinary skill in the art in view of Okada et al., Wood et al. and Itoh et al.

Wood et al. records only broadcasting programs. In particular, Wood et al. discloses that, based on user-input criteria, if sufficient video input sources are not available to allow recording of all shows (broadcasting programs) that meet the criteria, only the highest priority programming (also based on user-input criteria) will be recorded. See paragraphs [0038] and [0043] of Wood et al. Wood et al. does not disclose interrupting recording of digital image data that is not a broadcasting program in order to record a visual broadcast program that is a broadcasting program that is being broadcast, as recited in independent claim 36. Moreover, Wood et al. does not interrupt recording of anything, but merely discloses how to choose one broadcasting program over another when both are scheduled to be broadcast at the same time. Accordingly, one having ordinary skill in the art would not be taught to modify Okada et al. to result in Applicant's independent claim 36 features based on the teachings of Wood et al.

Itoh et al. does not relate to a system that records any visual broadcast programs. Itoh et al. relates to an apparatus/method in which the creation of a thumbnail image from moving

image data is interrupted if another moving image is to be recorded. Neither the thumbnail image nor the other moving image is a visual broadcast program of a broadcasting program that is being broadcast. Furthermore, the thumbnail image whose creation/recordation is interrupted is not "digital image data" that "is not from an internal memory of the image recorder" as now recited in independent claim 36. All of the image data recorded by Itoh et al. is from the Itoh et al. image recorder (the digital camera). Accordingly, one having ordinary skill in the art would not be taught to modify Okada et al. to result in Applicant's independent claim 36 based on the teachings of Itoh et al.

Thus, while the Office Action is correct that Wood et al. and Itoh et al. generally teach recording one kind of data with priority relative to another type of data, neither of the references provides any reason to modify Okada et al. to result in the combination of features recited in Applicant's independent claim 36. Thus, independent claim 36 and all of its dependent claims are patentable over Okada et al., Itoh et al. and Wood et al. Withdrawal of the rejection is requested.

Claims 44 and 59 stand rejected under 35 U.S.C. §103(a) over Okada et al., Itoh et al. and Wood et al., and further in view of Logan et al. (U.S. Patent No. 7,055,166). The rejection is moot in view of the cancellation of claims 44 and 59.

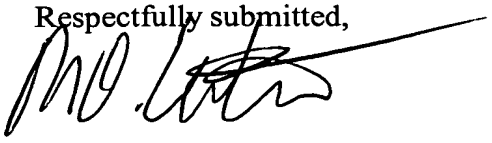
Claim 39 stands rejected under 35 U.S.C. §103(a) over the references applied against independent claim 36, and further in view of Browne (WO 92/22983). Claims 38 and 57 stand rejected under 35 U.S.C. §103(a) over the references applied against independent claim 36, and further in view of Fumio (JP-A-10-129082). The rejections are respectfully traversed.

Neither Browne nor Fumio overcomes the deficiencies noted above in Okada et al., Itoh et al. and Wood et al. with respect to independent claim 36. Thus, claims 38, 39 and 57, which depend from claim 36, also are patentable.

In view of the foregoing, Applicant respectfully submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



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